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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/501,751

07/19/2004

Hiroiyuki Kedula

2922-480

1121

6449

7590

05/12/2008

ROTHWELL, FIGG, ERNST & MANBECK, P.C.

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SUITE 800

WASHINGTON, DC 20005

EXAMINER

ROE, JESSEE RANDALL

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

05/12/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No. 10/501,751	Applicant(s) KEDUKA ET AL.	
	Examiner Jessee Roe	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 February 2008 has been entered.

Status of the Claims

Claims 1 and 5-8 are pending wherein claim 1 is amended; claims 2-4 are canceled; and claim 8 is new.

Status of the Previous Rejections

The previous rejection of claim 1 under 35 U.S.C. 102(b) as being anticipated by Shibata (US 4,636,270) is withdrawn in view of the Applicant's amendments to the claims. The previous rejection of claim 5 under 35 U.S.C. 103(a) as being unpatentable over Shibata (US 4,636,270) is withdrawn in view of the Applicant's amendments to the claims. The previous rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Shibata (US 4,636,270), and further in view of Shibata et al. (US 6,338,889) is withdrawn in view of the Applicant's amendments to the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrano et al. (US 6,139,652).

In regards to claim 1, Carrano et al. ('652) discloses a silver alloy composition having at least about 99.5 weight percent with the balance selected from the group consisting of aluminum, antimony, cadmium, gallium, germanium, indium, lithium, manganese, magnesium, silicon, tin, titanium, and zinc (col. 1, lines 48-58 and Tables 1-3). The Examiner notes that the compositions disclosed by Carrano et al. ('652) overlap the compositions of the instant invention, which is a prima facie case of obviousness. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed amounts of indium and tin from the compositions disclosed by Carrano et al. ('652) because Carrano et al. ('652) discloses the same utility throughout the disclosed ranges.

With respect to the recitation "for use in a reflection coating for an optical recording medium", the Examiner notes that this recitation would not limit the structure of the silver alloy. Therefore, this recitation has been considered an intended use of the silver alloy. MPEP 2111.02 II.

In regards to claim 5, Carrano et al. ('652) discloses hardening by internal

oxidation (col. 1, lines 58-67).

Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrano et al. (US 6,139,652) alone, or alternatively in view of Okamura et al. (US 6,104,530).

In regards to claims 6 and 8, Carrano et al. ('652) disclose a silver alloy composition as shown above. Although Carrano et al. ('652) do not specify that the silver alloy would be used as "A sputtering target", the Examiner notes that this recitation would not limit the structure of the silver alloy. MPEP 2111.02 II.

Alternatively, Okamura ('530) discloses that a silver or silver containing alloy would be used as a sputtering target in order to enable the metal film layers consisting of silver or silver-containing alloy and the high-reflective-index transparent film layers to be formed easily, repeatedly, and continuously (col. 11, line 45 – col. 12, line 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the silver alloy, as disclosed by Carrano et al. ('652), as a sputtering target as disclosed by Okamura ('530), in order to enable the metal film layers consisting of silver or silver-containing alloy and the high-reflective-index transparent film layers to be formed easily, repeatedly, and continuously, as disclosed by Okamura ('530) (col. 11, line 45 – col. 12, line 8).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carrano et al. (US 6,139,652) as applied to claim 1 above, and further in view of Shibata et al. (US 6,338,889).

In regards to claim 7, Carrano et al. ('652) disclose a silver alloy composition as

shown above, but Carrano et al. ('652) do not specify that the silver alloy would be used in an optical recording medium having a reflection coating consisting of the silver alloy.

Shibata et al. ('889) discloses that a silver metal or silver alloy would be preferred for an optical information recording disc in order to have a light reflecting layer that would have a high reflection to the laser light (abstract and col. 6, lines 14-35).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the silver alloy composition, as disclosed by Carrano et al. ('652), for the light reflecting layer of the optical information recording disc, as disclosed by Shibata et al. ('889), in order to achieve a high reflection to the laser light, as disclosed by Shibata et al. ('889) (col. 6, lines 14-35).

Response to Arguments

Applicant's arguments filed 25 January 2008 have been fully considered but they are not persuasive.

The Applicant primarily argues that the alloys claimed by Carrano et al. ('652) are binary alloys which contain silver and an element additive. In response, although the silver-base alloys in the claims of Carrano et al. ('652) are binary alloys, the Examiner notes that alloys 17-23 of Table 1 are tertiary silver-base alloys. The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. MPEP 2123 I. Therefore, it would be expected that up to

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two elements from the group consisting of aluminum, antimony, cadmium, gallium, germanium, indium, lithium, manganese, magnesium, silicon, tin, titanium, and zinc could be selected for a silver base alloy with at least 99.5 weight percent silver (col. 1, lines 48-58). Furthermore, in the case of Carrano et al. ('652), there would be a limited number of variations and one of ordinary skill could envisage all possible binary and tertiary alloys. MPEP 2144.08 (4)(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessee Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John P. Sheehan/
Primary Examiner, Art Unit 1793

JR

<div>Application Number</div> <div></div>	Application/Control No.	Applicant(s)/Patent under Reexamination	
	10/501,751	KEDUKA ET AL.	
	Examiner	Art Unit	
	Jessee Roe	1793	